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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte THOMAS E. WALSH

Appeal No. 2004-1169
Application No. 09/220,910

ON BRIEF

Before HAIRSTON, DIXON, and GROSS, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 5-15, 17-21, and 23-41, which are all of the claims pending in this application.

We REMAND.

BACKGROUND

Appellant's invention relates to system and method for automatically identifying and attaching related documents. An understanding of the invention can be derived from a reading of exemplary claim 2 which is reproduced below.

> 2. A method for identifying a secondary document having an un-specified location relative to a primary document in a document preparation environment comprising:
>
> processing said primary document to locate an un-selected indicator;
>
> identifying said secondary document associated with said un-selected indicator; and
>
> attaching said secondary document to said primary document to encapsulate said secondary document within said primary document.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Krause	5,526,520	Jun. 11, 1996
Bobo, II	5,675,507	Oct. 7, 1997
Fabbio et al. (Fabbio)	5,870,089	Feb. 9, 1999 (filed Nov. 24, 1997)
Watanabe	6,327,612	Dec. 4, 2001 (filed Dec. 22, 1998)

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's final rejection (Paper No. 10, mailed Dec. 19, 2002), the examiner's advisory action

(Paper No. 12, mailed Feb. 21, 2003), and the examiner's answer (Paper No. 15, mailed Jul. 30, 2003) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 14, filed May 12, 2003) for appellant's arguments thereagainst.

ACTION

In reaching our decision to remand the case to the examiner and appellant in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determination that this appeal is not ripe for a decision on the merits at this time.

We remand this application to the examiner for clarification of the status of the claims and the respective rejections. While we realize that appellant had an opportunity to file a reply brief in an attempt to clarify the status of the claims and the respective rejections, we find no Reply brief is noted in the file.

We find that the examiner's advisory action and the examiner's answer are confusing as to the status of the rejections of claims. First, we find that the examiner's statements in the attachment to the advisory action did not make it clear that the examiner was maintaining the two rejections under 35 U.S.C. § 103 since the examiner only discussed the merits of the rejection under 35 U.S.C. § 112, second paragraph. Therefore, appellant only presented arguments to the rejections under 35 U.S.C. § 112,

second paragraph. Second, the examiner agrees with appellant's statement of the issues and status of the claims as only having rejections under 35 U.S.C. § 112, second paragraph. (Answer at page 2.) Yet in the answer, the examiner includes the two rejections under 35 U.S.C. § 103. Third, the examiner includes only one of the two rejections under 35 U.S.C. § 112, second paragraph in the statement of the rejection, but then presents arguments to a rejection under 35 U.S.C. § 112, with respect to an omnibus claim. (Answer at page 13.) We are unsure if the examiner has previously set forth this rejection or if it is a new grounds of rejection. Fourth, in the examiner's brief statement of the rejection under 35 U.S.C. § 112, second paragraph, the examiner maintains that "un-selected indicator or unspecified location is not disclosed in the specification." (Final rejection at page 2.) We query the examiner how the lack of a specific disclosure makes the language of the claim indefinite or whether the examiner should alternatively consider the rejection under 35 U.S.C. § 112, first paragraph.

Therefore, we remand the application to the examiner to clarify the status of all the claims and rejections and thereafter afford appellant an opportunity to file an amended brief. Any supplemental examiner's answer and brief(s) should comply with the new rules of practice 37 CFR § 41.37 et seq.

CONCLUSION

This application, by virtue of its "special" status, requires immediate action by the examiner. **See** the Manual of Patent Examining Procedure, § 708.01(D) (8th ed., Rev. 1, Feb. 2003). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMANDED

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

JD/RWK

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